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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/074,544	05/08/1998	GORDON R. MEYER	P2248-472	2392
21839	7590	01/26/2004	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			HUYNH, BA	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			2173	

DATE MAILED: 01/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 22

Application Number: 09/074,544
Filing Date: 05/08/98
Appellant(s): Meyer et al.

MAILED

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Technology Center 2100

Andrew J. Bateman
For Appellant

Supplemental
EXAMINER'S ANSWER

This is in response to appellant's supplemental brief on appeal filed on 8/17/01 and the Reply brief filed on 12/26/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is substantially correct.

Minor changes is as follow:

Claims 1-5, 16-28, 39-45, 60-61 are rejected under 35 U.S.C. 103(a). Claims 6-15, 29-38, 46-59 are rejected under 35 U.S.C. 102(e).

Claims 2-23, 25-61 form the basis for the appeal. Claims 1 and 24 are not on appeal.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that the claims stand or fall together as separate groups and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,055,544	DeRose et al	4/2000
5,848,410	Walls et al	12/1998

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 6-15, 29-38, 46-59 are rejected under 35 U.S.C. 102(e). Claims 2-5, 16-23, 25-28, 39-45, 60-61 are rejected under 35 U.S.C. 103(a). Copies of the rejections are provided below.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 6-15, 29-38, 46-56 are rejected under 35 U.S.C. 102(e) as being anticipated by US patent #6,055,544 (DeRose et al).

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- As for claims 6, 29, 46: DeRose teach a method/means for providing a dynamically generated table of contents of a computerized help system (col. 8, lines 15-18), comprising:
 - indexing a file using HTML meta-tag for a first level of files of a first types,
 - scanning the files for HTML meta-tag for adding data to a table of contents (col. 15, line 1 - col. 19, line 35; figure 5),
 - dynamically generating a table of contents (col. 4, lines 42-49; col. 6, lines 11-15; col. 11, lines 38-52), using a template (figure 5), in response to the activation,
 - and displaying the generated table of contents 162.
- As for claims 7, 30, 47: The file is a help file (col.8, lines 15-18).
- As for claims 8, 31, 48: The file can be a text file with creator designation (col. 15, lines 23-25).
- As for claims 9, 32, 49: The file includes a HTML meta-tag for a title (col. 15, lines 1-20; col. 17, lines 62-66; col. 19, lines 16-18).
- As for claims 10, 33, 50: The indexing includes indexing each chapter within a file (col. 18, lines 22-45).
- As for claims 11, 34, 51: The table of contents is formatted using an HTML template (col. 15, lines 1-20; col. 18, lines 22-34).
- As for claims 12, 35, 52: It is implicitly included that the table of contents is provided upon user request.

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- As for claims 13, 14, 36, 37, 53, 54: The HTML defines a link to location of a document in the system. The document can be a file or a web page.

- As for claims 15, 38: The determining of whether a table of contents is to be generated is implicitly included.

- As for claims 55, 56: Examples 1 and 2 are templates for generating the table of contents. The tables only can be generated if the templates exist.

- As for new claim 57: Claim 57 recites the similar elements of claim 6, thus is rejected for the same reason as set forth in the rejection of claim 6. A formatted table of content is displayed in figure 9.

- As for claim 58: It is implicitly included that DeRose's help manuals (col. 8, lines 15-20) are stored in a folder.

- As for claim 59: Claim 59 recites the similar elements of claim 15, thus is rejected for the same reason as set forth in the rejection of claim 15.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-5, 16-28, 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #6,055,544 (DeRose et al), in view of US patent #5,848,410 (Walls et al).

- As for claims 1, 41: DeRose et al teach a method/means for displaying information to a user of a computer system, comprising:

activating a computerized information system (implicitly included),
dynamically generating a table of contents in response to the activation,
and displaying the generated table of contents 162 (figure 9).

DeRose et al fail to clearly teach that the table of contents is up-to-date. However, in an analogous art of generating of table of contents, Walls et al teach the displaying of up-to-date table of contents (col. 13, lines 17-45). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Walls' teaching of displaying an updated table of contents to DeRose et al. Motivation of the combining is for updating the table of contents.

- As for claims 2, 20, 25, 42: A document folder is indexed using HTML meta-tags for files of a first type (title of the files), scanning the files for HTML meta-tags of a second type identifying chapters in the files (col. 15, line 1 - col. 19, line 35; figure 5).

- As for claims 3, 21, 26, 43: The file can be a text file with creator designation (col. 15, lines 23-25).

- As for claims 4, 22, 27, 44: The file includes a HTML meta-tag for a title (col. 15, lines 1-20; col. 17, lines 62-66; col. 19, lines 16-18).

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- As for claims 5, 23, 28, 45: The file is a help file (col.8, lines 15-18).

- As for claims 16, 17, 39, 40: DeRose et al fail to clearly teach that the table of contents is up-to-date. However, in an analogous art of generating of table of contents, Walls et al teach the displaying of up-to-date table of contents (col. 13, lines 17-45). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Walls' teaching of displaying an updated table of contents to DeRose et al. Motivation of the combining is for updating the table of contents. It is implicitly included in Walls' teaching of updating the table of contents that the system generates an updated table of contents base upon the determination of whether a table of contents already exist and/or up-to-date by comparing the generating date.

- As for claims 18, 19: DeRose teach a method/means for providing a dynamically generated table of contents of a computerized help system (col. 8, lines 15-18), comprising:

indexing a file using HTML meta-tag for a first level of files of a first types,

scanning the files for HTML meta-tag for adding data to a table of contents (col. 15, line 1 - col. 19, line 35; figure 5),

dynamically generating a table of contents, using a template (figure 5), in response to the activation,

and displaying the generated table of contents 162.

DeRose et al fail to clearly teach that the table of contents is up-to-date. However, in an analogous art of generating of table of contents, Walls et al teach the displaying of up-to-date table of contents (col. 13, lines 17-45). It would have been obvious to one of ordinary skill in the

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art, at the time the invention was made, to combine Walls' teaching of displaying an updated table of contents to DeRose et al. Motivation of the combining is for updating the table of contents. It is implicitly included in Walls' teaching of updating the table of contents that the system generates an updated table of contents base upon the determination of whether a table of contents already exist and/or up-to-date by comparing the generating date.

- As for claim 24: DeRose et al teach a method/means for displaying information to a user of a computer system, comprising:

a viewer 162 for dynamically generating a list of book (figures 17, 18) in response to the user request,

and displaying the generated table of content 162 (figure 9).

DeRose et al fail to clearly teach that the list is up-to-date. However, in an analogous art of generating of table of contents, Walls et al teach the displaying of up-to-date table of contents (col. 13, lines 17-45). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Walls' teaching of displaying an updated table of contents to DeRose et al's list of book. Motivation of the combining is for updating the list.

- As for claim 60: DeRose et al fail to clearly teach the step determining if the table of contents needs to be generated if the table of content fails to exist or not up-to-date. However it would have been obvious to one of ordinary skill in the art, at the time the invention was made, implement the determining if the table of contents needs to be generated if not already exist or up-to-date. Motivation of the implementation is for generating an up-to-date table of content.

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- As for claim 61: Determination of an up-to-date condition based on modification date would have been in common sense and obvious to one of skill in the art.

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(11) Response to Argument

The DeRose reference. The DeRose reference relates to retrieving and displaying of electronic documents over World Wide Web (col. 1, line 44 - col. 2, line 33). On WWW information is presented to the user as a collection of documents. A site on a network which electronically publishes documents on the WWW documents is call a Web site (col. 2, lines 34-40). A Web site contains a group of related HTML documents. Web browser allows the user to retrieve and display one or more selected document from the table-of-contents of related documents (col. 2, line 66 - col. 3, line 45). Electronic documents can be a simple short text or as large as operation manuals for large systems (col. 8, lines 12-19). Conventionally, when any document selected from the listed documents is retrieved from a server by a client, the entire document is loaded into the client's memory. There is no protocol which allows access only a portion of the document. If the selected document is very large, the user must wade through irrelevant information to reach a desired portion of the document (col. 3, lines 46-67). DeRose solves the prior art problem by scanning (hierarchical indexing) the selected document to generate a table-of-contents for the document, from which a selected portion of a document may be rendered (col. 14, lines 40-53; col. 17, line 60 - col 19, line 58). The overall context of DeRose's invention is to permit the ability of prior art fixed documents to be modified or edited in a more simplified fashion when new tags are therefore added to the prior art HTML mark-up language version of the documents (See DeRose's Summary of the Invention and col. 21, line 40 - col. 22, line 7). This is similar in context

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with the appellants' invention as described on page 1-2 of the specification. As admitted by the appellants, DeRose teaches a document folder broken down into a hierarchy of books, chapters, pages...(Brief's page 6, 2nd par.). DeRose's document hierarchy is similar to the appellants' figure 2. The manual includes interactive self-contained objects (5:50-52) such as volumes, chapters, section, paragraphs (8:13-46; 18:65 - 19:3), which are equivalent to books ("a volume of a five volumes book") and files ("one chapter of a ten chapter book") within the operation manual folder. Note that a file is a basic unit of storage that enables a computer to distinguish one set of information from another. The self-contained objects (5:50-52; 8:18-20) are sets of information that are stored and retrieved independent from the others, thus are equivalent to files. Figure 9 discloses a Table-of-Content 160 which is an index of files comprising "Brakes", "Staying Aboard", "Wheels" and "Power Train", and a Table-of-Content 162 which is an index of elements within the "Brakes" file. More importantly, the manual further includes non-text objects such as graphic files 64. Graphic files can be documents (files) within a document (file) (8:39-46). Figure 3 discloses a large document folder which contains a hierarchy of self-contained content objects. The objects can be non-text files (col. 8, lines 13-46). Note that DeRose uses the word "objects" for both the self-contained text objects and the non-text objects graphic files. This is a further indication that each self-contained objects is equivalent to a file. In summary, DeRose's operation manual comprises at least non-text object files 64 and text object files.

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As for claims 6-7, 9, 13-14, 29-30, 32, 36-37, 46-47, 49, 53-54, 57-58: The appellants argue that DeRose does not teach the claimed limitation “indexing each file and a first level of each book of a predetermined folder for a files of a first type”, it appears that the appellants are equating DeRose’s teaching of “very large operation manual” as a single book instead as a help folder containing a hierarchy of sub-folders of books and files. As set forth above, DeRose’s operation manual includes interactive self-contained objects (5:50-52) such as volumes, chapters, section, paragraphs (8:13-46; 18:65 - 19:3), which are equivalent to books and files within the operation manual folder. The manual further comprises at least non-text object files 64. The Table-of-Content 160 (or Index), which list the title (first level of book) volumes “Brakes”, “Staying Aboard”, “Wheels”, and “Power Train”, is generated from the indexing of each file and a first level of each book of the operation manual folder for files of a first type. The appellants argue that DeRose’ table of content is not generated “after” the indexing for files of a first type. The table of content 162 is generated responsive to user selection of the Brake file in the index 160, thus is generated after the indexing of the Bicycle manual.

Based on the same rationale that DeRose’s teaching is within a single document only, the appellants further argue that DeRose does not teach the scanning “separated, individual files” for HTML tags. As set forth above, the operation manual is a help folder which contains a group of documents represented by volumes, chapters, sections, files... Per DeRose, each separate document of the operation manual (volume, chapter, section, file...) is

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scanned for HTML tags to generate the table of contents 160. In the examples given in figures 9 and 10 (col. 11, lines 46-53), a table-of-content is generated dynamically for any input word. The examples indicate that every separate individual document in the operation manual is scanned for HTML tags. Since the table-of-content can be generated dynamically for every input word, the appellants' argument that the table-of-content must be manually updated, therefore, is not persuasive.

As for claims 8,31,48: The appellants argue that DeRose does not teach the claimed "Creator designation". While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Claims must be given broadest reasonable interpretation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus the term "creator designation" in claim 8 can be reasonably interpreted as any marker, identifier, name, specifier, or indicator arbitrarily created by an author for the purpose of designation. DeRose's disclosure includes creator designations such as file name (col. 11, line 31 - col. 12, line 27) and "[http://www.ebt.com/pro/abook#EID\(13\)](http://www.ebt.com/pro/abook#EID(13))".

As for claims 10, 33 and 50: Based on the same rationale that DeRose's teaching is within a single document only, the appellants further argue that DeRose does not teach the generating a table of contents based on a multi-file system. As set forth above, DeRose's

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operating manual help folder is a multi-file system wherein each file (volume, chapter, section, paragraph) within the folder is scanned to generate the table of contents 160 (figure 9; col. 10, line 54 - col. 11, line 26. See also the incorporated by reference application 07/733,204, now patent 5,557,722, col. 13, line 1 - col. 15, line 36).

As for claims 11, 34, 51: In response to the argument that DeRose does not teach the HTML template for generating the table of contents, figure 12A and the examples given in column 15, lines 1-20 showing table-of-contents formatted according to an HTML template.

As for claims 12, 35, 52: The table-of-Content 162 is generated in response to user selection of the Brake file from the Index 160.

As for claims 15, 38, 59: Claim 15 recite the step determining whether a table-of-contents needed to be generated in reponse to the user selection of the help system. DeRose discloses the determination whether a table-of-contents needed to be generated in response to the user selection of an element of the operation manual. The element can be a document within the manual or the manual itself. If the selected element is too large then a table of content is generated (col. 13, lines 12-30). The appellants argue that DeRose teaches the displaying but not the generating the table-of-content. The argument is not persuasive since the table-of-contents must be generated so that it can be visualized on the display.

Furthermore, DeRose's objective is generating table-of-content for large document to avoid the loading of the entire document.

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As for claims 55, 56: In response to the argument that DeRose does not use a template for creating the table-of-contents, the template is disclosed in figure 12A (col. 12, lines 34-61) for converting from SGML to HTML. Without the conversion it would appear that the table-of-content can not be created. Thus the step determining whether the template exist is implicitly included in DeRose.

The Walls et al reference. In the same field of retrieving document in large database, Walls teach a method for quickly locate desired document without generating references to undesired documents. The method include index generator to continuously scanning HTML tags of all files within a file system to form an index for the file system. The index is updated hourly or daily (see Summary of the Invention).

As for claims 2-5, 16-23, 25-28, 39-45, and 60-61: Claims 2-5, 16-23, 25-28, 39-45, and 60-61 stand or fall together as a group. Broadest claim 41 recites the generating of an up-to-date table-of-contents in response to the activation of an information system. As set forth above, the table-of-content can be generated upon receipt of a user selection of an element (col. 18, lines 57-59), upon receipt of a user selection of an indexed file (e.g., "Brakes") in the Index 160. The table-of-content may also be generated in response to a user selection of the "Table-of-contents" option (figure 10, lower right corner). While the Table-of-Content can be generated dynamically (5:59 - 6:15), DeRose fails to clearly teach that the table-of-content is up-to-date. However, generating of up-to-date table of content is disclosed by Walls et al (Walls' col. 13, lines 17-45). It would have been obvious to one of skilled in the art, at the

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time the invention was made, to combine Walls' teaching of generating an up-to-date table-of-content to DeRose. Motivation of the combining is for updating the table-of-contents. The appellants continue to argue that DeRose's invention directs to the generating of table-of-contents for a single file only thus can not be combine with Walls' multi-file system. As set forth above, DeRose's teaching of large operation manual having volumes, chapters, sections is equivalent to a help folder having separate files and books. The argument, therefore, is not persuasive.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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January 20, 2004



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